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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,833	09/26/2000	Linda S. Mansfield	MSU 4.1-528	2531

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EXAMINER

BASKAR, PADMAVATHI

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 01/23/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/669,833

Applicant(s)

MANSFIELD ET AL

Examiner

Padmavathi v Baskar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29,30 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29,30 and 32-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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***Response to Amendment***

1. The amendment filed on 10/9/02 has been entered into the record. Claims 29-30 and 32-35 have been amended and are under examination.

2. The text of Title 35 of the U.S. Code not reiterated herein can be found in the previous office action.

***Rejections Withdrawn***

3. The terminal disclaimer filed on 10/9/02 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 6,344,337 has been reviewed and is accepted. The terminal disclaimer has been recorded. Therefore, the rejection of claims 29-30 and 32-35 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,344,337 in view of Harlow and Lane 1986 (chapter 6) is withdrawn.

4. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as U.S. Patent No. 6,153,394 at the time this invention was made. Accordingly, U.S. Patent No. 6,153,394 is disqualified as prior art through 35 U.S.C. 102(e), (f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. Therefore, the rejection of claims 29-30 and 32-35 under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al U.S. Patent No. 6,153,394 in view of Harlow and Lane 1986 (chapter 6) is withdrawn.

5. In view of amendments to the claims, the rejection of claims 29-30 and 32-35 under 35 U.S.C. 112, second paragraph is withdrawn.

6. In view of amendments to the claims, the rejection of claims 29-30 and 32-35 under 35 U.S.C. 103(a) as being unpatentable over Liang et al 1997 (Analytical Biochemistry; 250 (1) 61-

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5) or Liang et al 1998 (Infection and Immunity; 66 (5) 1834-1838) each in view of Harlow and Lane 1988 (Antibodies; Cold Spring Harbor) is withdrawn.

***New Objections and Rejections***

7. The amendment filed 10/9/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

16kD and 30kD antigen in claims 29-30.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29-30 and 32-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a New Matter Rejection** because the originally filed claims and the specification do not support a 16KD antigen and a 30KD antigen.

9. Claims 29-30 and 32-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. Applicant is referred to the interim guidelines on written description published June 15, 1998 in the Federal Register at Volume 63, Number 114, pp 32639-32645 (also available at [www.uspto.gov](http://www.uspto.gov)). This is a written description rejection.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111 (Fed. Cir. 1991), clearly states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." Vas-Cath Inc. v. Mahurkar, 19USPQ2d at 1117. The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." Vas-Cath Inc. v. Mahurkar, 19USPQ2d at 1116.

The claims encompass a method for producing an antibody and a monoclonal antibody against a S.neurona antigen selected from the group consisting of a 16kD and a 30kD antigen comprising: providing a microorganism containing a DNA that encodes a fusion polypeptide in which S.antigen selected from the group consisting of 16kD antigen and 30 kD antigen, culturing the microorganism and isolating the fusion polypeptide by affinity chromatography. Review of the present specification, the art of record, and a search of the sequence databases for polynucleotides and polypeptide sequences of a16 kD antigen and a 30(+4) kD antigen indicate that these sequences have not been identified nor described. Presently, in order to practice the invention as claimed the artisan must first obtain the polynucleotides and/or polypeptide sequences of a 16 KD antigen and a 30 kD antigen. The specification describes general methods of cloning cDNA sequences from expression libraries; however, the sequences obtained by this method for a16 kD antigen and a 30 kD antigen are not disclosed. The specification fails to provide any detail to any of the sequences of a 16 kD antigen and a 30 kD antigen. The claimed invention as a whole is not adequately described and is not conventional in the art as of Applicant's effective filing date. Possession may be shown by

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actual reduction to practice, clear depiction of the invention in a detailed drawing, or by describing the invention with sufficient relevant identifying characteristics (as it relates to the claimed invention as a whole) such that a person skilled in the art would recognize that the inventor had possession of the claimed invention. Pfaff v. Wells Electronics, Inc., 48 USPQ2d 1641, 1646 (1998). In the instant case, the claimed embodiments of the polynucleotides sequences needed to make and use the invention as claimed lack a written description. The specification fails to describe any polynucleotides or polypeptides encompassed in the claims with particularity to indicate that Applicants had possession of the claimed invention. The written description of a claim is evaluated on the basis of the claimed invention as a whole. Case law established that the requirement for written description relates to the subject matter defined by the claims. In re Wright, 9 USPQ2d 1649 (Fed. Cir. 1989). To this end, while antibodies exist which recognize a 16 kD antigen or a 30 kD antigen, no specific sequence which is recognized by these antibodies is disclosed. The skilled artisan cannot envision the detailed structure of the claimed DNA encoding the antigen which is critical to carry out the claimed methods of generating antibodies and thus, conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method. Case law has established that one cannot describe what one has not conceived. See Fiddes v. Baird, 30 USPQ2d 1481, 1483.

The claimed invention as a whole is not adequately described if the claims require essential or critical elements which are not adequately described in the specification and which are not conventional in the art as of Applicants effective filing date. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it and using it to raise antibodies. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) and Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016

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(Fed. Cir. 1991). One cannot describe what one has not conceived. See Fiddes v. Baird, 30 USPQ2d 1481, 1483. In Fiddes, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class.

10. Claims 29-30 and 32-35 are also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

#### ***Status of Claims***

11. No claims are allowed.

#### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padma Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4 PM EST

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Padma Baskar Ph.D.

11/12/02

*LFS*  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
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